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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BAYAT, BRADLEY B

ART UNIT

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3621

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/807,697	<b>Applicant(s)</b> CHEVREAU ET AL.	
	<b>Examiner</b> Bradley Bayat	<b>Art Unit</b> 3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 6-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Status of Claims***

The petition to revive the current application after abandonment of 6/15/2007 was granted on 11/21/2007. This communication is in response to remarks and amendment filed on July 6, 2007.

- Claims 1, 6-9, 11 and 12 have been amended.
- Claim 5 has been cancelled.
- Claims 1-4 and 6-12 remain pending.

### ***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1, the limitation "recording said formatted data onto said medium" in line 9 of the claim lacks antecedent basis for "said formatted data."
- Claim 4, the limitation "wherein the step of formatting the digital data..." has insufficient antecedent basis for said formatting.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 3, 4 and 6-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Söhne et al. (US 6,397,333 B1, hereinafter Söhne).**

As per claim 1, Söhne discloses a method of copying digital data representative of audio and/or video content from a source of digital data onto a medium, said method comprising the steps of:

- *encrypting* the digital data *representative of audio and/or video content* from said source of digital data using *an encryption key dependent* on a serial number contained in said medium (Figure 1, column 4, lines 35-64, audio and/or video data content is encrypted using an encryption key based on the serial number of the device – see also column 2, lines 45-57);
- to obtain data *encrypted* specifically for said medium (column 3, lines 30-33, a part of the signature is a device-specific, non-copy able feature – serial number of the device that identifies each device unambiguously) and
- recording said formatted data onto said medium (column 4, lines 64, controller then writes the data into a memory 6; column 4, lines 42-44, device refers to any storage medium with a controller).

As per claim 3, Söhne discloses the method of claim 1, wherein the serial number is a unique number for each medium (column 4, lines 50-51, serial number is a unique identification of the device).

As per claim 4, Söhne discloses the method of claim 1, wherein the step of formatting of the digital data to be duplicated is carried out using a secret-key encryption algorithm or a public-key algorithm (column 3, lines 32-53).

As per claim 6, Söhne discloses the method of claim 1, wherein the encryption key is furthermore dependent on a secret parameter contained in a reading device adapted for reading the digital data arising from said source (Fig 1 and associated text, encryption based on random number to decipher data at the host or reading device).

As per claim 7, Shone discloses a method of copying representative of audio and/or video content onto a medium, wherein the medium comprises a serial number the method comprising the following steps:

- sending of the serial number recorded on the medium to the reading device (figure 1, sending serial number to the reading device or host),
- *encrypting the digital data representative of audio and/or video content read using an encryption key dependent on the serial number to obtain data formatted specifically for said medium, (Figure 1, column 4, lines 35-64, audio and/or video*

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data content is encrypted using an encryption key based on the serial number of the device – see also column 2, lines 45-57), and

- recording on said medium the encrypted digital data (column 4, lines 64, controller then writes the data into a memory 6; column 4, lines 42-44, device refers to any storage medium with a controller).

As per claim 8, Söhne discloses the method of claim 7, wherein the encrypting step is carried out in the reading device (figure 1, encrypt 2)

As per claim 9, Söhne discloses the method of claim 7, wherein the reading device comprises means for reading the encrypted digital data contained in the medium (Fig 1, decipher data).

As per claim 10, Söhne discloses the method of claim 7, further comprising before performing the duplication of the digital data, a step of checking authorization to copy (Fig 1, authentication).

As per claim 11, Söhne discloses a reading device for reading digital data representative of audio and/or video content and for encrypting the digital data to be copied onto a medium, wherein it comprises a formatting circuit adapted for receiving a serial number contained in said medium and providing as output, data representative of audio and/or video content encrypted specifically for said medium using an encryption key dependent on said serial number and

wherein said encrypted data are intended to be copied onto said medium (see rejection of claim 1 above as per figure 1 and associated text).

As per claim 12, Söhne discloses a recording medium for digital data representative of audio and/or video content comprising a serial number which is unique or exhibits a low probability of being common with that of another medium, wherein it furthermore comprises recorded digital data, said digital data representative of audio and/or video content being encrypted specifically for said medium using an encryption key dependent on said serial number and of a secret parameter (see rejection of claim 1 above as per figure 1 and associated text).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Söhne in view of Akiyama et al. (5,805,699, hereinafter Akiyama).**

As per claim 2, Söhne discloses a method of copying digital data representative of audio and/or video content from a source of digital data onto a medium, said method comprising the steps of:

- *encrypting the digital data representative of audio and/or video content from said source of digital data using an encryption key dependent on a serial number contained in said medium (Figure 1, column 4, lines 35-64, audio and/or video*

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data content is encrypted using an encryption key based on the serial number of the device – see also column 2, lines 45-57);

- to obtain data *encrypted* specifically for said medium (column 3, lines 30-33, a part of the signature is a device-specific, non-copy able feature – serial number of the device that identifies each device unambiguously) and
- recording said formatted data onto said medium (column 4, lines 64, controller then writes the data into a memory 6; column 4, lines 42-44, device refers to any storage medium with a controller).

Söhne does not explicitly disclose that the serial number is recorded on the medium during manufacture of the medium.

Akiyama, however, teaches that the serial number of the storage medium is assigned uniquely to each medium at the factory before shipment (column 5, lines 34-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the serial number pre-assigned by the manufacturer to uniquely identify each medium in order to efficiently authenticate the medium so that illegal duplication of content is prohibited beyond the authorized medium.

**PLEASE NOTE:**

*Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially*



*teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.*

### ***Response to Arguments***

Applicant's arguments with respect to amended claims have been considered but are moot in view of the new ground(s) of rejection. The Examiner notes that Applicant's arguments did not address the limitation of claim 2 with regards to Akiyama as rejected above.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US 6,842,521 B2 to Nakamura for a Method and Apparatus to Control Coping from a Drive Device to a Data Reproducing Device.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday-Friday 8 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bradley Bayat/  
Primary Examiner, Art Unit 3621